

## R E M A R K S

Claims 1 - 13, 22 - 26 and 28 - 30 are pending.

Claims 1, 11, 12, 13, 22 and 28 - 30 are independent.

**REQUEST FOR RECONSIDERATION:  
PREMATURE FINAL REJECTION**

Applicants request that the finality of the Office Action be withdrawn, since it was premature. Specifically, the rejection of independent claims 1, 11 - 13 and 22 in the Final Office Action were made on newly cited art - U.S. Patent No. 6,035,281 to Crosskey.

An action will not be made final if it includes a rejection, on newly cited art, of any claim not amended by Applicant. MPEP 706.07(a). Such a rejection on newly cited art may not be made final even if other claims were amended to require newly cited art. MPEP 706.07(a).

In the Office Action mailed November 20, 2000, paper no. 13 (the "first Office Action"), independent claims 1, 11 - 13 and 22 were rejected as obvious in light of a combination of the McNatt, Linnen and Krauss references. Applicants then provided arguments distinguishing the claims from the cited references.

However, in the Office Action mailed July 24, 2001, paper no. 16 (the "final Office Action"), independent claims 1, 11 - 13 and 22 were then rejected as obvious in light of a combination of the McNatt, Linnen, Krauss and also Crosskey references. The Crosskey reference is newly cited art; it was not previously used in any rejection, much less the rejection of independent claims 1, 11 - 13 and 22.

Further, it appears that additional new references and subject matter (Goldberg, Wall Street Access, Bucci, Schumacher and officially noted subject matter) has been used as a new basis for rejected some or all of independent claims 1, 11 - 13 and 22. However, from the nature of the rejection it is unclear which claims or limitations such references and subject matter were applied to.

**RCE**

Applicants have filed a Request for Continued Examination herewith. However, in light of the premature finality of the Office Action, Applicants request that the fee for the Request for Continued Examination be **refunded** when it is deemed that the finality of the Office Action was premature.

**Section 103(a) Rejections**

Claims 1, 11 - 13 and 22 are rejected as being unpatentable over a combination of the McNatt, Linnen, Krauss and Crosskey references. Claims 2 - 10, 14 - 21 and 23 - 26 are rejected as being unpatentable over a combination of the McNatt, Linnen, Krauss and Jermyn references. Applicants respectfully traverse the Examiner's Section 103(a) rejections.

Applicants note that several limitations of the pending claims appear to have been ignored. For example, on page 4 of the Final Office Action there is the following incorrect characterization of the present claims:

"This [reference], once again, demonstrates the wide spread use of the marketing technique of one party directly paying a portion of a user's bill owed to another party as Applicant is claiming." (emphasis added)

This characterization clearly omits several claimed limitations of various claims, including a limitation in several pending claims that a billing statement (omitted in the Examiner's characterization above) include an offer (omitted in the Examiner's characterization above) to pay at least a portion of an amount due on the billing statement if the individual becomes a customer of a second entity (omitted in the Examiner's characterization above).

Independent Claims 1, 11, 12, 13.

As discussed previously, each of independent claims **1, 11, 12 and 13** generally include the following limitation:

*providing with the billing statement an offer to said individual to pay at least a portion of an amount due on said billing statement if said individual becomes a customer of said second entity*

On page 6, the Examiner concedes that none of the McNatt, Linnen, Krauss and Jermyn references "disclose "that the offer is being enclosed in a billing statement from the first entity".

Applicants also note that the newly-cited Crosskey reference does not refer to a billing statement at all, much less suggest the limitation above. Crosskey discloses only that another party may share in certain costs, not that any sort of offer is provided with a billing statement.

The Examiner also takes Official Notice on page 4 that it is known to

*"send acquisition solicitations (advertisements) to individuals who are not current customers of the business (further supported by Bucci ([U.S. Patent No.] 5,655,089) col. 3, line 55-67)".*

However, the cited portion of Bucci discloses only that a single envelope may carry to an individual a summary of billing statements from plurality of businesses, as well as advertising or bill-breakdown information. No solicitations to non-current customers are suggested by Bucci.

In fact, upon a reading of the entire Bucci reference it is clear that Bucci in fact discloses the opposite of the Examiner's assertion quoted above. Bucci discloses sending a summary billing statement to individuals who are current customers of the businesses (which bill them). The advertisements and bill-breakdown information which may be sent with the summary billing statement must be advertising from those businesses billing the individual.

Accordingly, Bucci teaches away from any notion of sending acquisition solicitations (advertisements) to individuals who are not current customers of the business to an individual, as the Examiner asserts.

Applicants also note that since the cited prior art does not suggest providing any offer which can be accepted, the prior art therefore cannot disclose or suggest the claimed limitation:

*receiving acceptance of said offer from said individual*

Finally, the Examiner implies that it would have been obvious to provide an offer as claimed which can be accepted with a billing statement from a first entity in order to provide increased revenue to the first entity. Office Action mailed August 2, 2000, page 7. These "motivations" are not suggested by the prior art, and may not even be true motivations at all, based on the prior art of record. It is unclear whether or how such a combination would increase revenue to the first party in the cited references.

**Claims 14, 19, 20, 21.**

Claims 14 - 21 have been canceled to be pursued in a continuing application, rendering the rejection in the present application moot.

**Independent Claim 22.**

Claim 22 includes the following limitation:

*receiving an offer with the billing statement to have at least a portion of said amount due paid by a third party in exchange for becoming a customer of said third party*

Thus, claim 22, as well as those claims dependent thereupon, are patentable for at least the reasons discussed above with respect to independent claims 1, 11, 12 and 13.

**Independent Claims 28 and 30.**

Claim 28 includes the following limitation:

*providing with the billing statement an offer to the customer to become a customer of the third party*

Claim 30 includes the following limitation:

*the billing statement [sent to a customer of a first entity] including an offer to the customer to become a customer of a second entity in exchange for paying at least a portion of the at least one amount due [on the billing statement]:*

Thus, claims 28 and 30 are patentable for at least the reasons discussed above with respect to independent claims 1, 11, 12 and 13.

**Independent Claim 29.**

Claim 29 includes the following limitation:

*providing an offer via a billing statement to said individual to pay at least a portion of said amount due if said individual becomes a customer of said second entity*

Thus, claim 29 is patentable for at least the reasons discussed above with respect to independent claims 1, 11, 12 and 13.

**Official Notice**

Applicants respectfully request that the Examiner clarify whether the Examiner believes that:

- (i) the rejections of claims 1, 11, 12, 13 and 22 could stand in light of only the McNatt, Linnen, Krauss, Crosskey and Jermyn references;
- (ii) the rejections of claims 1, 11, 12, 13 and 22 could stand in light of only the information in the McNatt, Linnen, Krauss, Crosskey, Jermyn and Goldberg references;

or

(iii) whether other subject matter not in the printed references, such as the officially noted subject matter, is required to sustain the rejection of claims **1, 11, 12, 13 and 22**.

In addition, Applicants had previously requested references to support the statements regarding officially noted subject matter and personal experience alleged to have been in the prior art. In response, the Examiner has characterized Applicants' arguments as "non-persuasive" and the official notice maintained. Applicants repeat the request for support of this subject matter.

Applicants note that **the burden is not on Applicants to persuade the Examiner of anything regarding officially noted subject matter**, especially where that officially noted subject matter is the basis for a rejection under Section 103(a). Per MPEP 2144.03, the burden is on the Examiner to provide a reference once such a request has been made. In addition, as discussed above the "numerous references and examples" do not support all of the officially noted subject matter used as the basis for the rejections for obviousness.

#### Proper Use of Official Notice

Finally, officially-noted subject matter cannot be used as the basis for a rejection under 102 or 103. In other words, official notice of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art.

See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference** work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.") (emphasis added);

In re Eynde, 480 F.2d 1364 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and **are not amenable to the taking of judicial or administrative notice.**") (emphasis added);

In re Pardo, 684 F.2d 912 (C.C.P.A. 1982) ("[T]his court will always **construe [the rule permitting judicial notice] narrowly** and will regard facts found in such manner with an eye

toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.") (emphasis added)

Official Notice may be used, if at all, to clarify the meaning of a reference. See, e.g., *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference disclosure**, perhaps to justify or explain a particular inference to be drawn **from the reference teaching**.") (emphasis added).

### Conclusion

For the foregoing reasons, it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

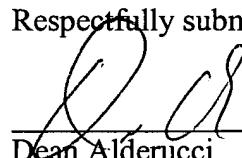
Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

### Petition for Extension of Time to Respond

Applicants hereby petition for a **three-month** extension of time with which to respond to the Office Action. Please charge \$920.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

  
Dean Alderucci

Attorney for Applicants  
Registration No. 40,484  
Alderucci@WalkerDigital.com  
Walker Digital Corporation  
Five High Ridge Park  
Stamford, CT 06905-1326  
203-461-7337 / voice  
203-461-7300 / fax

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Date